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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,759	02/28/2000	John Vivian Wood	SWIN 2012	9358
7812 7590 09/14/2004				
SMITH-HILL AND BEDELL 12670 N W BARNES ROAD SUITE 104 PORTLAND, OR 97229				
			EXAMINER THALER, MICHAEL H	
			ART UNIT 3731	PAPER NUMBER

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,759

Applicant(s)

WOOD ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-74 is/are pending in the application.
- 4a) Of the above claim(s) 64-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 1, 2004 has been entered.

Newly submitted claims 64-74 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I (claims 53-63) and II (claims 64-74) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product. For example, it could be used without heating the gripping element and returning it to a non-deformed condition.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 64-74 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 53, 55-57, 59 and 61-63 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bendel et al. (5,242,458). Bendel et al. show a biocompatible gripping device for surgical use including at least one deformable gripping element (at I) comprising shape memory material (col. 3, lines 55-63). The deformable gripping element (at I) inherently requires to be heated to a temperature above the martensite to austenite phase transition temperature to return it to the non-deformed condition, as broadly claimed. During its intended use, the gripping element I returns to its non-deformed condition after releasing the article as indicated in col. 3, lines 61-63. However, the gripping element, when used in a cold environment (below the martensite to austenite phase transition temperature) would inherently remain in its deformed condition after releasing the article since it would be in the martensite phase.

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Further, it would inherently return to its non-deformed condition upon heating (to room temperature for example) since heating it would change its state from the martensite to austenite. Since the rejected claims are apparatus claims rather than method of use claims and since the Bendel et al. device is inherently capable of being used as claimed, the rejection is proper. Alternatively, it would have been obvious that the deformable gripping element (at I) requires to be heated to a temperature above the martensite to austenite phase transition temperature to return it to the non-deformed condition for the reasons set forth above.

Claims 54, 58 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendel et al. (5,242,458). As to claim 54, Bendel et al. fail to disclose the specific phase transition temperature. However, it would have been obvious that the phase transition temperature of the nitinol gripping elements falls within the claimed range since they are in the austenitic phase at room temperature (since they apparently return to their original shape at room temperature as indicated in col. 3, lines 61-63) and since it is old and well known that the specific phase transition temperature of nitinol typically falls within the claimed range. As to claim 58, Bendel et al. fail to

disclose the specific percentages of titanium and nickel. However, it is old and well known to use the claimed percentages for a nickel titanium alloy in order to obtain the desired shape recovery. It would have been obvious to use the claimed percentages for the Bendel et al. nitinol so that it too would have this advantage. As to claim 60, Bendel et al. fail to disclose the claimed attachment means. However, it is old and well known in this art to use attachment means such as soldering or riveting in order to positively secure an insert to a jaw. It would have been obvious to use the claimed attachment means for the Bendel et al. insert and jaw so that it too would have this advantage.

Applicant's arguments filed June 1, 2004 have been fully considered but they are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (703)308-2154. The fax phone number for the

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organization where this application or proceeding is assigned is
(703)872-9306.

Any inquiry of a general nature or relating to the status
of this application or proceeding should be directed to the
receptionist whose telephone number is (703)308-0858.

mht
9/10/04



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731